The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LEON SALTSOV and GENNADIY GAPONYUK

Appeal No. 2006-0393
Application 09/503,122

ON BRIEF

Before GARRIS, BARRETT and OWENS, *Administrative Patent Judges.*

OWENS, *Administrative Patent Judge.*

DECISION ON APPEAL

This appeal is from a rejection of claims 1-6, 8 and 10-20. Claims 7 and 9 have been canceled.

THE INVENTION

The appellants claim a banknote validator, a serial flash memory module, and a method for updating the criteria used to

evaluate the authenticity of banknotes by a banknote validator.

Claims 1 and 6 are illustrative:

> 1. A banknote validator comprising a banknote processing channel, a series of sensors located along said channel for scanning a banknote as it moves past said sensors, a central processing unit for controlling the operation of said validator and receiving and processing the signals from said sensors, and a removable memory storage arrangement insertable in a receiving location of said validator, said removable memory storage arrangement when received in said receiving location forming an electrical communication path with said central processing unit, said central processing unit including a testing procedure which evaluates the integrity of any received removable memory storage arrangement and said central processing unit downloading information from said received removable storage arrangement for operation thereof upon positive evaluation of the integrity of said removable memory storage arrangement.
>
> 6. A serial flash memory module for updating a validator comprising a read only memory which includes an identification code specific to the serial flash memory module and a rewritable memory containing encrypted operation software for operating a validator, said encrypted software including encryption of at least part of said identification code.

THE REFERENCES

Itako et al. (Itako)	5,964,336	Oct. 12, 1999
Saltsov	6,142,284	Nov. 7, 2000
Mazur et al. (Mazur)	6,241,069	Jun. 5, 2001
	(effective filing date on or before	Feb. 5, 1999)
Meyer et al. (Meyer)	6,301,344	Oct. 9, 2001
		(filed Nov. 4, 1998)

THE REJECTIONS

The claims stand rejected as follows: claim 6 under 35 U.S.C. § 102(e) as anticipated by Meyer; claims 1-6, 8 and 10-15 under 35 U.S.C. § 103 as obvious over Mazur in view of Meyer; claims 16-18 under 35 U.S.C. § 103 as obvious over Mazur in view of Itako; claims 16-20 under 35 U.S.C. § 103 as obvious over Mazur in view of Meyer and Itako; and claims 1-6, 8 and 10-20 under the judicially created doctrine of obviousness-type double patenting over Saltsov in view of Meyer.

OPINION

We affirm the rejections of claims 16-18 over Mazur in view of Itako and over Mazur in view of Meyer and Itako, and reverse the other rejections.

Rejections of claims 16-18 under 35 U.S.C. § 103

Mazur discloses "a currency handling system having the capability to learn to accommodate new types of currency bills, analyze selected attributes of the bills and independently generate master information associated with the selected attributes which may be used in evaluating subsequent currency bills" (col. 1, lines 30-34). The system includes a removable flash card (82) which has its own flash memory and may be electrically connected to a currency handling machine's flash memory (86) to provide updates or to copy

from the machine's flash memory (col. 34, lines 50-53; col. 35, lines 18-29; col. 36, lines 40-43 and 54-61; figure 9).

Itako discloses a bill identifying apparatus having sensors (7a and 7b) that are easily replaceable with sensors having bill inspection lines which are different or larger in number than those of the replaced sensors (col. 6, line 22 - col. 7, line 26).

The appellants argue that Mazur does not evaluate the integrity of the flash memory card (brief, page 13). Such evaluation is not required by claims 16-18. The appellants do not direct any argument toward the combination of Mazur and Itako.

We therefore are not convinced of reversible error in the examiner's rejections of claims 16-18.

Rejection of claim 6 under 35 U.S.C. § 102(e) over Meyer

Claim 6 requires a serial flash memory module having a read only memory which includes an identification code specific to the serial flash memory module and a rewritable memory containing encrypted operating software which includes encryption of at least part of the identifying code.

The examiner argues (final rejection mailed January 25, 2002, pages 2-3) that Meyer discloses:

> 2. a rewritable memory containing an encrypted operating software (see col. 17 lines 50 and 51);

> 3. said encrypted operating software including an encryption of at least part of said identification code (note that the encryption key "may be used to encrypt any data stored in the phone" - see lines 51-54, which said data also inherently includes said identification code);

The portion of Meyer relied upon by the examiner discloses the following:

> A firmware algorithm creates a soft key based on the ASIC seed and the serial number. This means each phone has a unique (actually dependent on the number of serial number bits used) key which can be used to encrypt any data stored in the phone. The serial number is in a FLASH memory device which means it can be copied or modified, however the seed is in a non-reprogrammable device.

The only data that Meyer discloses as being written to the flash memory is the serial number (col. 17, lines 48-49). Meyer discloses that encryption takes place at a remote service center and that if data generated at the phone location were desired to be secured, an algorithm would encrypt the data using a soft key obtained from a seed and the serial number (col. 17, lines 41-49 and 57-60). Meyer does not disclose that the flash memory has encrypted software including encryption of at least part of the serial number.[1]

[1] The examiner does not address the rejection of claim 6 in the "response to argument" section of the examiner's answer (supplemental examiner's answer mailed November 24, 2004).

Thus, we find that the examiner has not established a *prima facie* case of anticipation of the invention claimed in the appellants' claim 6.

Rejections under 35 U.S.C. § 103 of claims 1-6, 8 and 10-15 over Mazur in view of Meyer, and claims 19 and 20 over Mazur in view of Meyer and Itako

Independent claims 1 and 19 require a central processing unit including a testing procedure which evaluates (claim 1) or confirms (claim 19) the integrity of a received removable memory storage arrangement. The relevant requirements of independent claim 6 are set forth above with respect to the rejection of that claim over Meyer.

The examiner argues that Meyer discloses a "central processing unit (1) including a testing procedure which evaluates the integrity of any received removable memory storage arrangement for operation thereof upon positive evaluation of the integrity of said removeable [sic] memory storage arrangement (see col. 16, lines 60-67 and col. 17, lines 1-35 and 61-63 of Meyer et al)" (final rejection mailed January 25, 2002, pages 5-6).

The portions of Meyer relied upon by the examiner do not disclose that the flash memory is removable. Moreover, the only data that Meyer discloses as being written to the flash memory is the phone's serial number (col. 17, lines 48-48). Meyer does not

disclose that the flash memory contains downloadable information, and does not disclose writing to the flash memory data other than the phone's serial number. The examiner has not established that Meyer's disclosure of a flash memory limited to storing a phone's serial number would have fairly suggested, to one of ordinary skill in the art, extending Meyer's disclosure of serial number checking to evaluating the integrity of Mazur's removable flash memory for transferring data to or from a currency handling machine's flash memory.

The examiner argues that "Meyer et al also includes remote downloading/uploading of data, records and operation program codes, as stated in the abstract" (supplemental examiner's answer, page 5). The abstract discloses that "a one-wire, high speed communication controller facilitates high speed downloading and uploading of pay telephone data, records, and operating program code." The abstract does not disclose downloading data to the flash memory or uploading data therefrom.

The examiner does not explain how Mazur and Itako remedy the above-discussed deficiency in Meyer as to claim 6.

For the above reasons we conclude that the examiner has not carried the burden of establishing a prima facie case of obviousness

of the invention claimed in the appellants' claims 1-6, 8, 10-15, 19 and 20.

Obviousness-type double patenting rejection of claims 1-6, 8 and 10-20

Independent claims 1, 16 and 19 require a removable memory storage arrangement. The relevant requirements of independent claim 6 are set forth above with respect to the rejection of that claim over Meyer.

In the final rejection (mailed January 25, 2002) the examiner's total argument regarding the obviousness-type double patenting rejection is that "[t]he claims of the '284 patent [Saltsov] disclose a banknote validator having removable sensors, memory and a central processing unit. Meyer et al discloses a currency validator having flash memory and using encryption techniques to secure the flash memory-based system" (page 15). In the supplemental examiner's answer the examiner argues that "[r]egarding US Patent 6,142,284 it is noted that the described prior art provides the necessary teachings and motivation required for maintenance of the double patenting rejection described in the final action" (page 7).

Saltsov's claims recite removable sensors, but not a removable flash memory. As discussed above, Meyer does not disclose a removable flash memory. Saltsov's claims do not include the

characteristics of the flash memory required by the appellants' claim 6 set forth above, and neither does Meyer as explained above regarding the rejection of that claim over Meyer.

We therefore conclude that the examiner has not established a *prima facie* case of obviousness-type double patenting.

DECISION

The rejections under 35 U.S.C. § 103 of claims 16-18 over Mazur in view of Itako and over Mazur in view of Meyer and Itako are affirmed. The rejections of claim 6 under 35 U.S.C. § 102(e) over Meyer, claims 1-6, 8 and 10-15 under 35 U.S.C. § 103 over Mazur in view of Meyer, claims 19 and 20 under 35 U.S.C. § 103 over Mazur in view of Meyer and Itako, and claims 1-6, 8 and 10-20 under the judicially created doctrine of obviousness-type double patenting over Saltsov in view of Meyer, are reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

BRADLEY R. GARRIS)
Administrative Patent Judge)
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LEE E. BARRETT) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
) INTERFERENCES
)
)
TERRY J. OWENS)
Administrative Patent Judge)

TJO/lg

Dennison Associates
133 Richmond Street West Suite 301
Toronto, ON M5H2L7
CANADA